

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Greenbaum

THIS OPINION IS NOT
CITABLE
AS PRECEDENT OF
THE TTAB

Date: November 6, 2003

Cancellation No. 92041064

Impact Restaurants L.L.C.

v.

Sizzling Platter, Inc.

Before Simms, Bottorff and Holtzman, Administrative
Trademark Judges.

By the Board.

Impact Restaurants L.L.C. has filed a petition to
cancel Registration No. 2101637 for HOPPERS and
Registration No. 2143520 for the mark HOPPERS GRILL &
BREWING COMPANY for use in connection with restaurant and
bar services.¹ As grounds for cancellation, petitioner

¹ Registration No. 2101637 issued on September 30, 1997,
claiming October 14, 1996 as the date of first use anywhere, and
November 3, 1996 as the date of first use in commerce.
Registration No. 2143520 issued March 10, 1998, claiming
September 15, 1996 as the date of first use anywhere, and
December 15, 1996 as the date of first use in commerce. Section
8 affidavits have been accepted for both registrations.

alleges that respondent's marks, as used in connection with respondent's services, so resemble petitioner's applied-for marks, BARLEYHOPPERS and BARLEY HOPPERS for restaurant and lounge services, as to be likely to cause confusion or mistake, or to deceive.²

With regard to the issue of priority, petitioner alleges that: petitioner first used the mark BARLEY HOPPERS for restaurant and bar services at least as early as March 31, 2001; a third party, ADCOPE L.L.C., and its predecessor in interest, ADCOPE partnership, have continuously used the mark M.J. Barleyhopper's for brew pubs and sports bars since at least February 12, 1991; ADCOPE L.L.C. owns Idaho State Registration 14541, registered August 4, 1994³; and that petitioner and ADCOPE L.L.C. entered into a "Territorial Trademark Assignment Agreement" ("Territorial Assignment") on October 13, 2000 through which petitioner acquired:

all of the right, title and interest in the mark M.J. BARLEYHOPPER'S and the mark BARLEYHOPPER'S and all of the goodwill of the business symbolized by the marks for the territory which is outside of a

² Application Serial No. 76172675, filed October 13, 2000, and Application Serial No. 76172675, filed November 30, 2000, respectively.

³ Petitioner attached as Exhibit C to the petition to cancel a copy of Idaho State Registration 14541, issued to ADCOPE partnership on August 4, 1994 for the mark M.J. BARLEYHOPPERS BREWERY & SPORTS PUB in stylized form, for use in connection with brew pub and sports bar services, claiming February 12, 1991 as the date of first use in Idaho.

circle with a radius of two hundred (200) miles having at its center, ADCOPE's current place of business at 621 21st Street, Lewiston, Idaho.⁴

Petitioner argues that its acquired rights and goodwill in the marks M.J. BARLEYHOPPER'S and BARLEYHOPPER'S predate respondent's first use of its marks HOPPERS and/or HOPPERS GRILL & BREWING COMPANY, and that BARLEYHOPPERS, BARLEY HOPPERS and M.J. BARLEYHOPPER'S are legal equivalents.⁵

Respondent denied the salient allegations in its answer, and asserted the following "affirmative defenses": "assignment in gross and phantom transaction"; "petitioner cannot assert the retained ownership rights of a third party"; "petitioner lacks standing and the alleged assignor is an indispensable party"; "trademark misuse, sham transaction and bad faith adoption"; "break in continuity of use"; "waiver, laches, estoppel, acquiescence"; "under principles of the common law, the Lewiston, Idaho goodwill is localized and petitioner purchased through the assignment no goodwill";

⁴ Petitioner attached as Exhibit A to the petition to cancel a copy of the assignment document.

⁵ Petitioner also alleges that it filed a separate concurrent use application for the mark BARLEY HOPPERS for restaurant and lounge services, but provided no additional information about the concurrent use application.

"petitioner has no right to a non-concurrent registration because petitioner cannot make the exclusive use oath and the alleged assignor's quit claim assignment claims no ownership of BARLEYHOPPERS"; "there is no likelihood of confusion"; and "petitioner can not tack to Idaho use, petitioner lacks priority and petitioner's use and infant goodwill is confined to Florida".

This case now comes up on respondent's motion for partial summary judgment on the issue of priority. Petitioner filed an opposition to the motion, and respondent filed a reply thereto.⁶ Additionally, respondent filed a motion to strike portions of the declaration that petitioner submitted in support of its response to the summary judgment motion, and to strike related portions of said response.

Before we turn to the merits of the summary judgment motion, we address several issues.

Notice of Insufficient Fees

As an initial procedural point, we note that petitioner seeks to cancel two registrations, but has only submitted a fee sufficient to file a petition to

⁶ The stipulation (filed April 28, 2003) to extend petitioner's time to respond to the summary judgment motion is granted.

cancel one registration. The statutory filing fee is \$300 per class per registration against which the petition to cancel is filed. See Trademark Rule 2.112(b) and TBMP §§305 and 308.5.

Pursuant to petitioner's previously submitted written authorization, petitioner's Deposit Account 06-2120 will be charged an additional \$300.00 to cover the requisite additional filing fee.

Overlength Briefs

Next, we note that petitioner's responses to respondent's summary judgment motion and motion to strike are 39 and 37 pages long, respectively, not including the certificates of service. Trademark Rule 2.127(a) provides: "The brief in support of the motion and the brief in response to the motion shall not exceed 25 pages in length," and "[e]xhibits submitted in support of or in opposition to the motion shall not be deemed to be part of the brief for purposes of determining the length of the brief." Accordingly, petitioner's responses to the pending motions are stricken from the record and will be given no further consideration. See *Ron Cauldwell Jewelry, Inc. v. Clothestime Clothes, Inc.* 63 USPQ2d 2009 (TTAB 2002) (reply brief was untimely and exceeded page limit) and *Estate of Shakur v. Thug Life Clothing Co.*, 57

USPQ2d 1095, 1096 (TTAB 2000)(filing of two briefs in an attempt to circumvent page limitation improper).

In view thereof, we will not consider petitioner's responses to the pending motions or respondent's reply brief regarding the summary judgment motion. See Trademark Rule 2.127(a).

Motion to Strike

Petitioner has submitted in support of its response to the summary judgment motion the declaration of its president, Dilip Kanji ("Kanji Declaration"). As noted above, respondent has moved to strike the declaration.

As a general rule, the Board disfavors motions to strike, and will not strike matter unless it clearly has no bearing on the issues involved. Although we have the authority to grant respondent's motion to strike the declaration as conceded pursuant to Trademark Rule 2.127(a), we choose not to do so in this case. Instead, we will consider the Kanji Declaration for whatever probative value it may have regarding petitioner's alleged priority, the sole issue now before us on summary judgment. We will only consider those matters which are based on the declarant's personal knowledge.⁷

⁷ We note, however, that even if we had considered the Kanji Declaration in its entirety, we would have come to the same result on the summary judgment motion.

In view thereof, respondent's motion to strike is denied. In addition, to the extent the motion to strike pertains to petitioner's response to the summary judgment motion, the motion to strike is moot.

Summary Judgment Motion

In support of the summary judgment motion, respondent argues that there is no genuine issue of material fact that it has priority over petitioner, and, therefore, we must dismiss the cancellation proceeding with prejudice. As grounds therefor, respondent contends that after the PTO rejected petitioner's pleaded intent-to-use applications based on likelihood of confusion with the registrations that petitioner now seeks to cancel, petitioner:

conceived of a disingenuous plan to contrive or manufacture [a] fictitious priority date earlier in time than the Respondent's priority date. The plan, once implemented, involves a phony attempted quit claim assignment of non-existing common law service mark rights having no good will in the Petitioner's trade area. The attempted assignment purports to leave the assigner [sic] with an unsupportable common law claim to a bifurcated portion legal title, an empty claim of right to use and fictitious good will outside the assignor's long term trade area at a single location in Northern Idaho. The assignee's intent was to transport the phantom claim to a bifurcated portion of legal title, the empty right to use and the imaginary good will across 3,000 miles to Florida.

The attempted assignment, if valid and if it transferred something other than non-existing rights and empty good will, created impermissible

concurrent bifurcated legal title in two independent business entities, without coordinated quality control to protect the public. The quit-claim assignor has retained its priority date in its trade area, its mark, its good will and all its assets, trade secrets and customer base in Northern Idaho. Yet, the Petitioner now claims the benefit of the assignor's common law Idaho priority date in Florida, where the assignor has no common law rights and no good will.

The Petitioner's transparent tacking ploy gained no common law service mark rights, no good will and no basis to claim to priority.

The relevant portions of the Kanji Declaration essentially reiterate the allegations of priority noted in the introductory section to this order.

A party is entitled to summary judgment when it has demonstrated that there are no genuine issues as to any material facts, and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). The evidence must be viewed in a light favorable to the nonmoving party, and all justifiable inferences are to be drawn in the nonmovant's favor. *Opryland USA Inc. v. The Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992).

Upon careful consideration of the arguments and evidence presented by the parties, and drawing all inferences with respect to the motion in favor of petitioner as the nonmoving party, we find that there is

no genuine issue of material fact regarding respondent's priority of use.

Specifically, in support of the summary judgment motion, respondent submitted the declaration of its Executive Vice President and General Counsel attesting to respondent's 1996 use dates.⁸ Therefore, there is no genuine issue of material fact that respondent has been using the marks HOPPERS and HOPPER'S GRILL & BREWING COMPANY continuously since November 3, 1996 and December 15, 1996, respectively. Nor is there a genuine issue of material fact that because petitioner filed its applications based on a *bona fide* intention to use the marks in commerce, the October 13, 2000 filing date of those applications is the constructive use date, and the earliest date on which petitioner can rely for purposes of establishing priority.⁹ See *Zirco Corp. v. American Telephone and Telegraph Co.*, 21 USPQ2d 1542 (TTAB 1991). Of necessity, therefore, petitioner's priority claim is based on its contentions that it obtained "all of the right, title, and interest" in the marks M.J. BARLEYHOPPER'S and BARLEYHOPPERS, and all of the related

⁸ Respondent attached to the declaration soft copies of the subject registrations.

⁹ In fact, petitioner first used the mark BARLEY HOPPERS in commerce on March 31, 2001. Kanji Dec. par. 58.

goodwill through the Territorial Assignment from Adcope, and that Adcope's February 12, 1991 date of first use of those marks inures to petitioner's benefit.

However, there is no genuine issue of material fact that Adcope had no rights and goodwill to assign beyond the 200 mile retained use area, and thus that petitioner is not entitled to claim priority under Section 2(d) based on said rights and goodwill. To the contrary, the Territorial Assignment states that Adcope "is the owner of the mark M.J. BARLEYHOPPER'S" and that "Adcope and its predecessor have used the mark on or in connection with a Brew Pub and Sports Bar in an area within a radius of two hundred (200) miles surrounding Lewiston, Idaho, since February 12, 1991." It therefore appears that Adcope has not used the mark M.J. BARLEYHOPPER'S outside the 200 mile retained area, and that Adcope has no rights or goodwill beyond that area.¹⁰

Petitioner submitted as exhibit 10 to the Kanji Declaration the title page of a telephone directory covering three counties in Washington and five counties in Idaho, and the page on which M.J. Barleyhopper's

¹⁰ According to the Territorial Assignment, Adcope also assigned to petitioner rights to BARLEYHOPPER'S, a mark Adcope does not appear to own, and, based on the evidence of record, does not

Brewery & Sports Pub is listed. To the extent petitioner relies on the directory listing to establish Adcope's rights and goodwill beyond the 200 mile retained area, such reliance is misplaced. The enumerated counties are either entirely within the 200 mile retained area, or, as in the case of Idaho County, the largest cities are within that radius. Therefore, the directory listing alone (not an advertisement) does not raise a genuine issue of material fact regarding the nature and extent of Adcope's rights and goodwill in the mark M.J.

Barleyhopper's beyond its retained area. Moreover, we do not see how any possible goodwill in a mark that a restaurant may have outside of a 200-mile radius from its single location can aid an applicant with a restaurant approximately 3000 miles away in Florida.

Finally, we note that even if we were to find that the Territorial Assignment constitutes a proper assignment, the mark M.J. BARLEYHOPPER'S is not legally equivalent to BARLEYHOPPERS or BARLEY HOPPERS. Marks are legal equivalents if they create the same, continuing commercial impression such that a consumer would consider them both the same mark. *Dial-A-Mattress Operating*

appear to be using as a service mark to identify a brew pub and sports bar.

Corp., 240 F.3d 1341, 57 USPQ2d 1807, 1812-13 (Fed. Cir. 2001). Therefore, a minor difference in the marks, such as pluralization or an inconsequential modification or modernization of the later mark, would not preclude a finding that the marks are legal equivalents. *Id.*; *In re Loew's Theatres, Inc.*, 223 USPQ 513, 514 n.5 (TTAB 1984), *aff'd*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985)(the marks DURANGOS and DURANGO are legal equivalents). Thus in *Dial-a-Mattress*, the marks 1-888-M-A-T-R-E-S-S and (212) M-A-T-T-R-E-S were viewed as legal equivalents, whereas in *Van Dyne-Crotty Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 17 USPQ2d 1866 (Fed. Cir. 1991), the marks CLOTHES THAT WORK. FOR THE WORK YOU DO and CLOTHES THAT WORK were not.

M.J. BARLEYHOPPER'S creates the impression of an individual's name, with the designation BARLEYHOPPER'S serving as the surname, while BARLEYHOPPERS and BARLEY HOPPERS are both nouns, and create different commercial impressions from M.J. BARLEYHOPPER'S. Therefore, Adcope's February 12, 1991 date of first use of the mark M.J. BARLEYHOPPER'S does not inure to petitioner's benefit.

Respondent has demonstrated a *prima facie* case that there is no genuine issue of material fact regarding

priority that requires trial for resolution. The Kanji Declaration does not raise or rebut any genuine issue of material fact. Accordingly, petitioner cannot prevail on the priority question, and its Section 2(d) claim must fail.

In view thereof, respondent's motion for partial summary judgment on the issue of priority is granted. Moreover, because priority is an essential element of a Section 2(d) claim, the petition to cancel is dismissed with prejudice.